REMARKS/ARGUMENTS

The Examiner is thanked for the performance of a thorough search. The Abstract has been amended to comply with the word limit requirement. By this amendment, no claims have been added, cancelled, or amended. Hence, Claims 1-20 are pending in the application.

SUMMARY OF REJECTIONS/OBJECTIONS

1. Objections Not Based on Prior Art

The Office Action has objected to the ABSTRACT for being longer than 150 words. Accordingly the ABSTRACT has been amended to be 150 words or less.

2. Rejections Based on Prior Art

The Office Action rejected Claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over US Application No. 2001/0056489 to Ariga (*Ariga*). Specifically, the Office Action states that it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of *Ariga* implicitly shows the elements and limitations of the claims. However, Applicants respectfully submit that *Ariga* does not expressly or inherently teach every element of the claimed invention. Therefore, the Office Action fails to present a *prima facie* case of obviousness, and the rejection of Claims 1-20 under §103(a) is respectfully traversed.

Claim 1 recites,

A method for determining which advertisements to include with electronic content delivered to users over a network, the method comprising the steps of:

storing sequence information that indicates a sequence for a plurality of advertisements, wherein each of said plurality of advertisements is associated with corresponding delivery criteria;

receiving a request to provide over said network a piece of electronic content that includes a slot for an advertisement;

comparing slot attributes of said slot with delivery criteria of said advertisements to determine a subset of said plurality of advertisements which qualify for inclusion in said slot; and

from said subset of advertisements, selecting an advertisement to include in the slot based, at least in part, on relative positions, within said sequence, of the advertisements in said subset.

ARIGA

As a preliminary matter, it should be noted that *Ariga* involves a fundamentally different environment than that required by Claim 1. Specifically, *Ariga* teaches a regional information distribution system (See *Ariga,* ¶ 0009 and ¶0043). In *Ariga,* advertisers input advertising data into an information input terminal. The advertising data is transferred to a "concentrated management server", which divides the data into menu categories for display on "handy terminals." This advertising data is stored on the concentrated management server until a designated date and time of distribution. At this time, the data is transferred to an appropriate regional distribution server that distributes the advertisements via radio base stations. Finally, handy terminals acquire the advertising data for a designated region when positioned within the area of a radio base station.

At a very high level, *Ariga* and the claimed invention are both about delivery of electronic advertisements. However, beyond that general similarity, the two systems are fundamentally different. Specifically, Claim 1 is about how to fill advertisement slots in requested pieces of electronic content. *Ariga,* on the other hand, has nothing to do with filling slots. This fundamental difference is reflected throughout the specific limitations of Claim 1. Specifically, Claim 1 contains specific limitations that are not taught or suggested by *Ariga.* For example, (1) in *Ariga,* delivery criteria are never compared to slot attributes of a slot in a piece of electronic content, and (2) *Ariga* does not teach receiving a request for such electronic content that contains slots for advertisements. Finally, it is emphasized that *Ariga* could not implement the method for selecting an advertisement from a set of advertisements to include in a slot because in *Ariga* advertisements are never competing for a slot. Therefore, *Ariga* does not teach every element in Claim 1, and the rejection of Claim 1 under §103(a) is respectfully traversed.

IN ARIGA, ADVERTISEMENT DELIVERY CRITERIA ARE NOT COMPARED TO SLOT ATTRIBUTES OF A SLOT IN A PIECE OF ELECTRONIC CONTENT

Referring now to specific limitations in Claim 1 that are not disclosed or suggested by *Ariga, Ariga* does not teach "**comparing slot attributes of [a] slot with delivery criteria of [an] advertisement** to determine a subset of said plurality of advertisements which qualify for inclusion in the slot." Although *Ariga* may teach the designation of delivery criteria such as "region, date and time, period and other preferences of distribution, "(*Ariga,*, ¶ [0039]) *Ariga* does not teach nor suggest comparing such criteria to slot attributes of a slot in a piece of requested electronic content. Instead, in *Ariga,* the "concentrated management server" merely receives advertising data, and if delivery criteria are associated with an advertisement, the

concentrated management server merely distributes the advertisement in accordance with the delivery criteria, for example, to a specified region at a specified date and time. (*Ariga,* ¶ 0043). Thus, the "concentrated management server" never ***compares*** the delivery criteria to any slot attributes of any slot to determine a subset of qualifying advertisements. Instead, the "concentrated management server" only receives and follows instructions on when and where to deliver the advertisements. Thus, no language in *Ariga* teaches **comparing slot attributes of a slot** with the delivery criteria of an advertisement as required by Claim 1.

Moreover, *Ariga* does not teach comparing slot attributes to advertisement delivery criteria **to determine a subset of advertisements that qualify for said slot**. In *Ariga,* advertisements are never divided into subsets based on whether they qualify for slots; instead, the concentrated management server divides the advertising data based on predefined advertising categories, not slot qualification, and the "categories of the advertising data are prepared to be a menu in the handy terminals." (*Ariga,* ¶ 0043). Therefore, *Ariga* does not teach comparing slot attributes of a slot with delivery criteria of advertisements to determine a subset of the advertisements that qualify for inclusion in the slot as required by Claim 1.

ARIGA DOES NOT TEACH RECEIVING A REQUEST TO PROVIDE OVER A NETWORK A PIECE OF ELECTRONIC CONTENT THAT INCLUDES A SLOT FOR AN ADVERTISEMENT

Additionally, *Ariga* cannot teach comparing slot attributes of a slot with delivery criteria of an advertisement because *Ariga* does not teach or suggest receiving a request to provide over a network a "piece of electronic content that includes a slot for an advertisement."

In *Ariga*, when users enter an area of a regional radio base station, users receive all requested category advertisements associated with that region. Thus, the "handy terminals" are

supplied with all of the advertisement data of a selected category stored on the regional distribution servers. (See *Ariga,* FIG 2, FIG 3, ¶ 0043 and 0054). This advertisement data is then presented in the form of a list on the "handy terminal" for selecting advertisements (See *Ariga,* ¶ 0044). Therefore, it is clear that in *Ariga*, users are supplied with a list or window "pop-up" menu for selecting advertisements already retrieved by the handy terminal from the regional distribution server, and **the system does not receive a request to provide electronic content over a network,** as required by Claim 1. In *Ariga,* all advertising data in a particular category for that region are **automatically** sent to the user's handy terminal and no request is made for a particular piece of electronic content that contains a slot for an advertisement.

Moreover, Claim 1 requires receiving a request to provide a piece of **electronic content containing slots for advertisements**. *Ariga* contains no language indicating a piece of electronic content containing a slot for advertisements. In *Ariga*, the electronic content is the advertisement itself, and there are no such things as "slots" with "slot attributes." This is significantly different in comparison to Claim 1, because requested electronic content contains **a slot for an advertisement in addition** to other content, such as would be, for example, on a webpage, or e-mail message. Thus, Claim 1 requires that electronic content contain a **slot for an advertisement**, and each slot in the piece of electronic content contains slot attributes. Moreover, as *Ariga* teaches a menu-driven advertising system, users are never requesting electronic content with slots, but only advertisements. This difference is significant, as Claim 1 requires receiving a request to provide electronic content that includes a slot for advertisement, and not actually receiving a request to provide the advertisement itself.

Thus, *Ariga* does not teach receiving a request to provide electronic content with slots for advertisements, and therefore, cannot be construed to teach the comparison of slot attributes to advertisement delivery criteria.

IN ARIGA, ADVERTISEMENTS ARE NOT COMPETING FOR A LIMITED NUMBER OF SLOTS, AND ADVERTISEMENTS ARE NOT COMPETING TO BE DISPLAYED IN THE SAME SLOT

It is emphasized that because there may be a limited number of slots in a piece of electronic content, and because a subset of advertisements qualifying for the slot may include more than one advertisement, advertisements would be competing for the slot, and Claim 1 discloses a method of selecting an advertisement to include in the slot based, at least in part, on relative positions within a sequencing order. However, in contrast, *Ariga* does not teach a system where advertisements are competing for slots, and therefore, cannot possibly teach the method as recited in Claim 1. In *Ariga,* the concentrated management server merely receives advertising data, "divides the advertising data into categories", wherein the "categories of the advertising data are prepared to be a menu in the handy terminals." (*Ariga,* ¶ [0043]). Thus, *Ariga* is menu driven such that **users select ads for viewing**. In this manner, the system in *Ariga* would never require selecting particular ads for slots because there is no ad competition for the same slot. Users independently choose ads.

It is therefore emphasized that the method of Claim 1 and *Ariga* recite completely different functions. While *Ariga* teaches a method for distributing a bulk of ads for regional distribution, Claim 1 recites a method **for selecting an advertisement** from a plurality of advertisement for a slot in an electronic piece of content.

Therefore, because *Ariga* fails to teach or suggest every element of Claim 1, the rejection of Claim 1 under §103(a) is respectfully traversed.

PENDING CLAIMS

The pending claims not discussed so far are either (1) dependant claims that depend on an independent claim that is discussed above, or (2) computer-readable medium versions of the claims discussed above. Because each of the dependant claims includes the limitations of claim(s) upon which it depends, the dependant claims are patentable for at least those reasons the claims upon which the dependant claims depend are patentable. Removal of the rejections with respect to the dependant claims and allowance of the dependant claims is respectfully requested. In addition, the dependent claims introduce additional limitations that independently render them patentable. Due to the fundamental difference already identified, a separate discussion of those limitations is not included at this time.

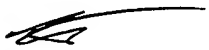
For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



Brian D. Hickman
Reg. No. 35,894

1600 Willow Street
San Jose, CA 95125
(408) 414-1080
Date: August 10, 2004
Facsimile: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

on August 10, 2004 by Darci Sakamoto

Darci Sakamoto